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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,812	12/01/2003	Tsutomu Okada	17291	5537
23389 7590 11/29/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER YABUT, DIANE D	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,812

Applicant(s)

OKADA, TSUTOMU

Examiner

Diane Yabut

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's amendment received on 09/04/2007.

The examiner acknowledges the amendments made to the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chu** (U.S. Patent No. **5,968,056**).

Claims 1, 3-6, 9-10, and 13-15: Chu discloses a substantially cylindrical cap **1** including a cylindrical wall and having a circular end portion including a holding mechanism which holds a distal end portion of a snare wire **70** in a loop form in an inner portion of the cylindrical wall, and an attachment portion **5** which attaches the cap to an end portion of an endoscope **25**, wherein the holding mechanism has a plurality of engagement pieces (adjacent to **90**, **68a-c**, **68a'-c'**) and a plurality of corresponding portions (in between **68a-c** and **90**, and **90** and **68a'-c'**) which hold the distal end portion of the snare wire between the engagement piece and the corresponding portion, said plurality of engagement pieces and being respectively distanced from each other in a circumferential direction of the circular end portion, and each of the engagement pieces is sectioned from the corresponding portion by a pair of vertical notches

Annotated Fig. 1 of Chu (5,968,056)

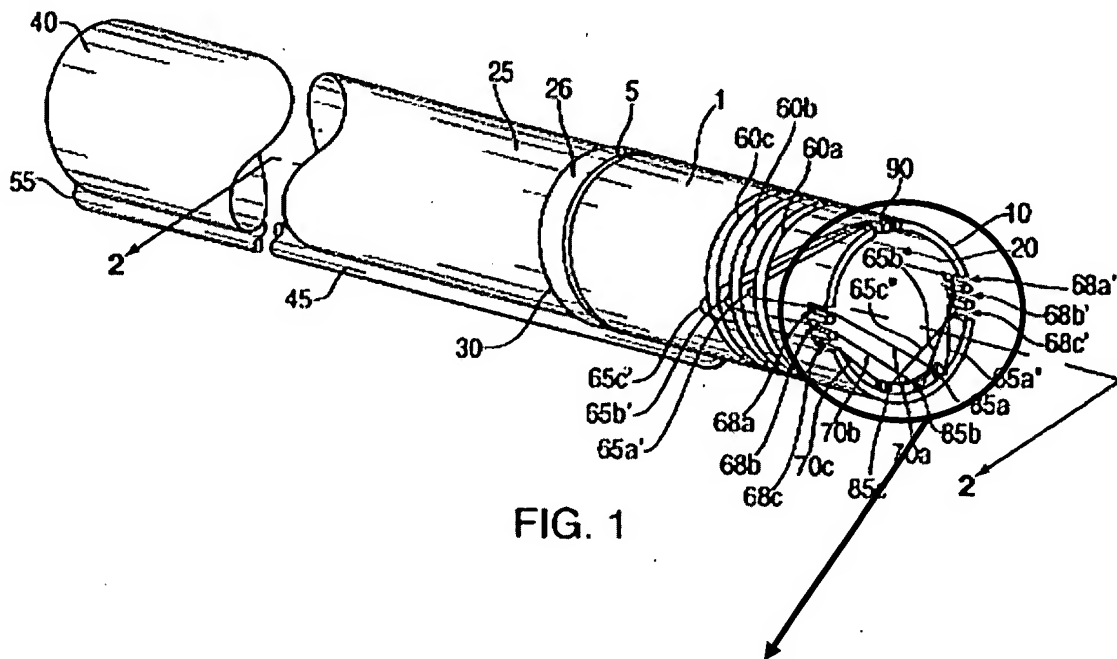
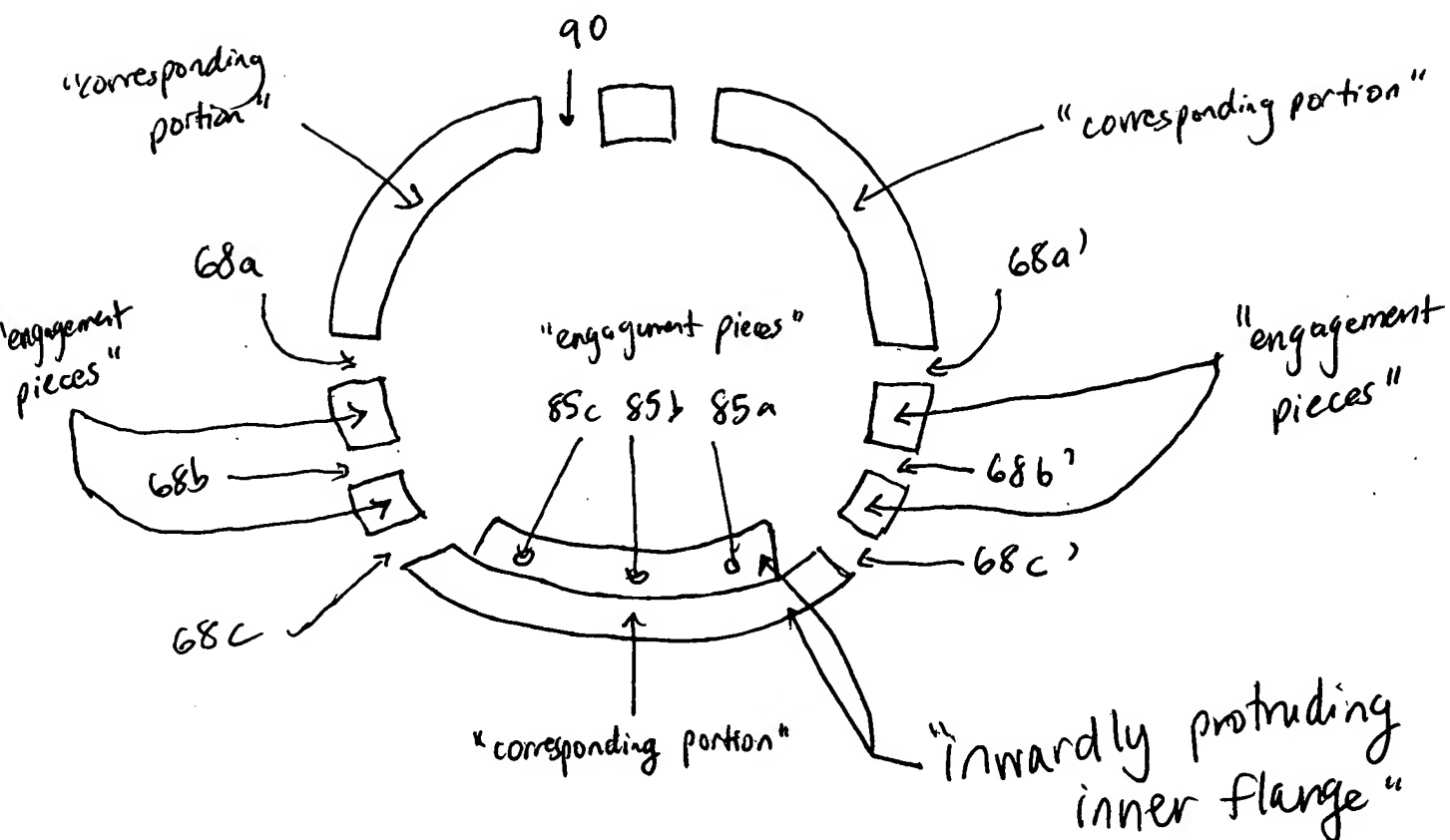


FIG. 1

(FRONT VIEW)



90, 68a-c, 68a'-c' which are distanced at the circular end portion in the circumferential direction and formed at a substantially right angle with the circumferential direction - in that they possess a width (Figure 1 (Figures 1 and 4)). Chu also discloses the plurality of engagement pieces (adjacent 68a-c and 90, and 90 and 68a'-c') being arranged in the same interval in the circumferential direction and each of the engagement pieces and each of the corresponding portions (in between 68a-c and 90, and 90 and 68a'-c') directly contact opposite sides of the end portion of the snare wire to hold the end portion therebetween (Figure 1).

Chu discloses the inner flange (at distal end of **10**) having a plurality of lateral notches **90, 68a-c, 68a'-c'** extending in the circumferential direction, and each said pair of vertical notches extend toward the cylindrical wall from both ends of each lateral notch (Figure 1).

Chu discloses the circular end portion having a plurality of lateral notches extending in the circumferential direction between the inner flange and the cylindrical wall, and each said pair of vertical notches **90, 68a-c, 68a'-c'** extend toward the cylindrical wall from both ends of each lateral notch (Figure 1).

Chu discloses the corresponding portion (in between **68a-c** and **90**, and **90** and **68a'-c'**) having a flange provided so as to inwardly protrude from the cylindrical wall, the engagement piece (adjacent **90, 68a-c, 68a'-c'**) having separation portions separated from each other by a notch portion formed in the inner flange, and the snare wire is supported between the flange and the separation portions (Figure 1).

Chu discloses the engagement pieces and the corresponding portions in between **68a-c** and **90**, and **90** and **68a'-c'**) being alternately arranged in the circumferential direction of the circular end portion (Figure 1).

Chu discloses the claimed device except for the engagement pieces (adjacent to **90**, **68a-c**, **68a'-c'**) being inwardly protruding from the cylindrical wall. However, Chu discloses engagement pieces (ports **85a-c**) being formed in the inner flange of the cylindrical wall, or inwardly protruding from the cylindrical wall so as to inwardly protrude from the end portion of the wall (Figure 1). It would have been obvious to modify the notches **90**, **68a-c**, **68a'-c'** and engagement pieces adjacent to **90**, **68a-c**, **68a'-c'** to also be protruding in order to facilitate a more secure engagement of the distal end portion of the snare wire and it was well known in the art that flanges or lips having coupling portions that extend axially into a distal circular end portion provides an abutment wall that effectively prevents disengagement of a snare wire.

Claims 2, 7-8, and 17: Chu discloses the claimed device except for the engagement piece and the corresponding portion each elastically holding the snare wire therebetween, the engagement piece being able to swivel or bend to a side where the circular end portion is positioned with respect to the corresponding portion and the engagement piece holding the snare wire between its outer surface and one surface of the corresponding portion when caused to swivel and the snare wire being pressed against the corresponding portion by an elastic return force of the engagement piece. It would have been obvious to one of ordinary skill in the art at the time of invention to provide an engagement piece and corresponding portion that elastically hold the snare

wire therebetween and the engagement pieces and corresponding portions being able to swivel, depending on the material used to form the cap, such as an elastic, flexible polymer material well known in the art, in Chu since it was known in the art that flexible polymeric materials used in endoscopic caps are biocompatible and allow for greater movement and manipulation of snare wires.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Chu** (U.S. Patent No. **5,968,056**) in view of **Suzuki** (U.S. Patent No. **6,068,603**) and **Smith** (U.S. Patent No. **6,517,539**).

Claim 11: Chu discloses the claimed device except for a snare sheath into which the snare wire is inserted and a flexible tube which has an opening on an end side, the opening communicating with the inner side of the cap, which is arranged outside the insertion portion of the endoscope when the cap is attached to the endoscope, and is used to insert the snare sheath in which the snare is inserted therethrough, wherein fixing means for fixing the snare sheath so as to be capable of being released is provided in the vicinity of a base end portion of the flexible tube, and a fixture for fixing the snare sheath for preventing the snare sheath to move in an axial direction of the snare sheath against the flexible tube.

Suzuki teaches snare sheath **18** into which the snare wire **16** is inserted and a flexible tube **9** which has an opening on an end side, the opening communicating with the inner side of the cap **10**, which is arranged outside the insertion portion of the endoscope when the cap is attached to the endoscope, and is used to insert the snare

sheath in which the snare is inserted therethrough. It would have been obvious to one of ordinary skill in the art at the time of invention to provide a snare sheath and flexible tube, as taught by Suzuki, to Chu since it was known in the art that using a sheath effectively protects and guides the snare wire before deployment.

Smith teaches a fixture 354 for fixing the snare sheath for preventing the snare sheath to move in an axial direction of the snare sheath against the flexible tube (Figure 10; col. 7, lines 10-27). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a fixture to prevent axial movement of the snare sheath against the flexible tube, as taught by Smith, to Chen in order to allow the snare to move relative of the sheath.

4. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki** (U.S. Patent No. **6,068,603**) in view of **Smith** (U.S. Patent No. **6,517,539**).
Claims 12 and 16: Suzuki discloses a device for use in combination with an endoscope comprising a substantially cylindrical cap **10**, an attachment portion which attaches the cap to an end portion of an endoscope, and a flexible tube **9** whose end opening communicates with the inner side of the cap, which is arranged outside an insertion portion of the endoscope when the cap is attached to the endoscope and used to insert a snare sheath **18** of a high-frequency snare **16** therein, an end portion of a snare wire of the high-frequency snare inserted in the cap through the flexible tube being expanded and arranged in the cap wherein fixing means **23** for fixing the snare sheath of the high-frequency snare so as to be capable of being released is provided in

the vicinity of the base end portion of the flexible tube (Figure 1B, col. 6, line 11 to col. 6 line 29, col. 11, lines 4-7).

Suzuki discloses the claimed device except for a fixture for fixing the snare sheath being disposed around the snare sheath to inwardly press an outer peripheral surface of the snare sheath to fix the snare sheath and preventing the snare sheath to move in an axial direction of the snare sheath against the flexible tube

Smith teaches a fixture 354 for fixing the snare sheath being disposed around the snare sheath to inwardly press an outer peripheral surface of the snare sheath to fix the snare sheath and preventing the snare sheath to move in an axial direction of the snare sheath against the flexible tube (Figure 10; col. 7, lines 10-27). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a fixture to prevent axial movement of the snare sheath against the flexible tube, as taught by Smith, to Suzuki in order to allow the snare to move relative of the sheath.

Response to Arguments

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DY

A handwritten signature in black ink, appearing to read "M J Hayes", with a long horizontal flourish extending to the right.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER